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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/824,478   | 04/15/2004  | Jean-Yves Legendre   | 239209US26                   | 6516             |
| 22850  | 7590        | 10/19/2007           |                              |                  |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | EXAMINER<br>WALCZAK, DAVID J |                  |
|  |             |                      | ART UNIT                     | PAPER NUMBER     |
|  |             |                      | 3751                         |                  |
|  |             |                      | NOTIFICATION DATE            | DELIVERY MODE    |
|  |             |                      | 10/19/2007                   | ELECTRONIC       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/824,478             | LEGENDRE, JEAN-YVES |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | David J. Walczak       | 3751                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-13, 15, 19, 20, 23, 29, 30, 34, 35, 37, 39, 46, 48, 54 and 61-67 is/are rejected.
- 7) ☐ Claim(s) 60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/5/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 5-7,14,16-18,21,22,24-28,31-33,36,38,40-45,47,49-53 and 55-59.

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 30, 34, 35 and 39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are positively claiming the finger of a user while the human body is considered to be non-statutory subject matter.

Claim should be amended to read "...the means to attach is adapted to attach the applicator to an end portion of a single finger." On line 11 of claim 34, "which attaches" could be amended to read "for attaching". Claim 35 could be amended to read "...said attachment arrangement is adapted to attach the applicator device to a single finger." Claim 39 could be amended to read "...which is adapted to adhesively couple the applicator device to a least one finger."

Such language would clearly indicate that the finger is not intend to be part of the claimed combination.

It is noted that withdrawn claims 31, 36, 38, 40 and 41 also appear to be claiming the finger and should be amended as described above before this case can be allowed.

### ***Potential Claim Rejections - 35 USC § 112***

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Upon rejoinder, withdrawn claims 27 and 49 would be rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 27, an antecedent basis for "the container" should be defined (it appears that claim 27 should depend from claim 26, as opposed to claim 20).

In regard to claim 49, an antecedent basis for "said means to establish communication" should be defined (this term was removed from claim 34 in the most recent amendment).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 8, 9, 10, 11, 12, 13, 19, 20, 29, 30, 34, 35, 37, 46, 48, 54, 61-65 and 66 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Laub in view of Schuck. In regard to claim 1, Laub discloses an applicator for the application of a product comprised of a reservoir 10 having first and second opposing sides with a first side facing a finger when the applicator is mounted on a finger, means 18 to attach the applicator to a finger, an applicator portion 25 having a first surface configured to engage a portion of a body during use and a second surface secured to the second side of the reservoir located immediately adjacent the second surface of the applicator

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portion and being isolated from the reservoir prior to a first usage of the device and a breakable membrane 29 for establishing communication between the reservoir and the applicator in response to an operating action during the first use of the device wherein the membrane 29 forms the second side of the reservoir, i.e., viewing Figure 4, the reservoir's lowest most "side" (i.e., the "second side") is formed by membrane 29 while portions 27 and 28 define side walls of the reservoir that are distinct from the lowest side formed by the membrane 29. Although the product does not permeate through the applicator as claimed, attention is directed to the Schuck reference, which discloses another toothbrush wherein the applicator (through which the product flows) can be either bristles 104 or a sponge 120 (through which the material permeates) in order to enable a user to employ a sponge to apply product to the oral cavity. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the bristles in the Laub device can be replaced with a sponge (through which the product can permeate) in order to enable a user to employ a sponge to apply product to the oral cavity. Further, as the length of the bristled section of the Laub device extends substantially along the length of the reservoir, the substituted sponge would also extend along the same length. Accordingly, the second surface of the applicator portion (i.e., the sponge) and the second side of the reservoir have respective lengths wherein the second surface of the applicator and the second side of the reservoir would be in contact with each other "along substantially all of their respective lengths". In regard to claim 2, the means to attach the applicator includes a finger stall 18. In regard to claims 3 and 4, the operating action includes pressure exerted on the

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first side of the reservoir. In regard to claims 8 and 9, the first side of the reservoir is deformable to thereby establish the communication (see page 2, lines 32-35). In regard to claim 10, the sponge applicator constitutes a porous material. In regard to claim 11, sponge material 120 of Schuck is considered to be "fibrous". In regard to claim 12, the applicator includes a sponge material. In regard to claim 13, the applicator portion 25 is made from a "resiliently deformable" material. In regard to claim 19, the first side of the reservoir is parallel to the face of the applicator (see Figure 2). In regard to claim 20, although the front of the applicator portion does not have a circular shape, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that that applicator portion can be designed to have any suitable shape, including the claimed shape, without effecting the overall operation of the device. In regard to claim 29, the toothpaste in the reservoir is considered a "cosmetic" in that it improves the appearance of the teeth. In regard to claim 30, the applicator is attached to a single finger via attachment means 18. In regard to claims 34, 35, 46 and 48, as discussed supra, the Laub device includes an cosmetic applicator attached to a single finger and comprised of a reservoir, applicator portion, attachment arrangement and a breakable membrane to establish communication as claimed. In regard to claim 37, the reservoir is positioned between the finger and the applicator. In regard to claim 54, the first surface of the reservoir has a convex shape (see Figure 5). In regard to claims 61-63 the sponge applicator would cover an opening in the membrane such that the product would flow through the broken membrane and pass through the applicator to an application surface thereof. In regard to claims 64 and 65,

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as discussed above, the claimed structure is met by the prior art. In regard to claim 66, the second surface of the applicator portion and the membrane have a length and are in contact with each other over "substantially" all of their length (see page 2, lines 27)

Claims 15, 23, 39 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laub in view of Schuck, as applied above, and further in view of MacDonald. Although the Laub device employs a finger stall to attach the device to a finger, and not an adhesive with a removable film, attention is directed to the MacDonald reference, which discloses another finger attached toothbrush wherein an adhesive 16 protected by a removable film 22 is employed to attach the device to a finger. Such an arrangement renders the device to be easily packaged and opened (see column 1, lines 1-22). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ such an adhesive (which obviously would be hypoallergenic since it is to be placed in a users mouth) to attach the Laub device to a finger (as opposed to the stall) in order to render that device to be easily packaged and opened.

#### ***Allowable Subject Matter***

Claim 60 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

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Applicant's arguments filed 10/5/07 have been fully considered but they are not persuasive. The Applicant contends that the Laub reference is no longer applicable against the claims in that this reference does not disclose the claimed structure and specifically does not disclose a membrane that forms the second side of the reservoir. However, as discussed above in detail, membrane 29 of Laub is considered to define the second side of the reservoir.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huson Gregory can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David J. Walczak  
Primary Examiner  
Art Unit 3751

DJW  
10/13/07